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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,098	12/04/2001	Tonya Torri	CS11027	9467

20280 7590 09/19/2005

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LIBERTYVILLE, IL 60048-5343

EXAMINER
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SAMS, MATTHEW C

ART UNIT	PAPER NUMBER
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2643

DATE MAILED: 09/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/006,098	<b>Applicant(s)</b> TORRI ET AL.	
	<b>Examiner</b> Matthew C. Sams	<b>Art Unit</b> 2643	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 March 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 10 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-9 and 12-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This office action has been modified in response to the amendment filed on 3/10/2005.
2. Claims 10 and 11 have been canceled.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The applicant fails to specifically state the location of the first surface of the second extending portion for the examiner to determine its location.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-9 and 12-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Janninck et al. (US-6,768,899 hereinafter, Janninck)

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding claim 1 Janninck teaches a handheld wireless device comprising two housing portions, connected together in a manner that the second housing portion rotates in a planar motion about the connection to the first housing portion. (Fig. 2 [260, 210 and 270]) Janninck teaches of a closed position that is when the second housing surface is adjacent to the first housing surface. (Fig. 1 [100]) Janninck teaches an open position where the first surface and second surface are exposed. (Fig. 2 [100]) Janninck teaches keypad (Fig. 2 [232]) on the inner surface of the second housing portion. (Col. 3 lines 22-35) Janninck teaches a user interface on the first surface that is exposed when the second housing portion is in the open position and concealed when the second portion is in the closed position. (Fig. 2 [230])

Regarding claim 2, Janninck teaches a user interface that includes a set of volume buttons. (Col. 3 lines 27-35)

Regarding claim 3, Janninck teaches a first housing portion that includes a first rotating portion and an extended portion. (Fig. 4 [250]) Janninck teaches a second housing portion that includes a second rotating portion and an extended portion. (Fig. 4 [120])

Regarding claim 4, Janninck teaches a second extended portion that extends over the user interface when in the closed position. (Fig. 1 & Fig. 2)

Regarding claim 5, Janninck teaches a first housing portion and second housing portion are substantially the same size. (Fig. 1 [100] and Fig. 4 [120 & 250])

Regarding claim 6, Janninck teaches an open position that has a 180° displacement between the first and second housing portions. (Fig. 2)

Regarding claim 7, Janninck teaches a user interface located at the natural resting place of an index finger on the second housing portion, which the applicant defines as the natural resting place. (Col. 3 lines 22-35)

Regarding claim 8, the limitations of claim 8 are rejected as the same reason set forth in claim 7.

Regarding claim 9, Janninck teaches a handheld wireless device comprising two housing portions, connected together in a manner that the second housing portion rotates in a planar motion about the connection to the first housing portion, each housing device with an inner and outer surface. (Fig. 2 [260, 210 and 270], Fig. 3 and Fig. 4) Janninck teaches a closed position when the second housing inner surface is adjacent to the first housing inner surface. (Fig. 1 [100]) Janninck teaches an open position where the first inner surface and second inner surface are exposed, with 180°

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separating the open position from the closed position. (Fig. 2 [100]) Janninck teaches a user interface on the first inner surface that is exposed when the second housing portion is in the open position and concealed when the second portion is in the closed position. (Fig. 2 [234]) Janninck teaches keypad (Fig. 2 [232]) on the inner surface of the second housing portion. (Col. 3 lines 22-35) Janninck teaches the user interface is on the inner surface of the second housing portion. (Fig. 2 [234])

Regarding claim 12, Janninck teaches buttons for increasing and decreasing the volume. (Col. 3 line 58 through Col. 4 line 7)

Regarding claim 13, the limitations of claim 13 are rejected as the same reason set forth in claim 7.

Regarding claim 14, the limitations of claim 14 are rejected as the same reason set forth in claim 9.

Regarding claim 15, Janninck teaches a user interface with a first volume button and a second volume button. (Col. 3 lines 22-35)

Regarding claim 16, Janninck teaches a second housing portion with two positions, one planarly adjacent to the first housing portion and a second position where the second housing portion is only partially planarly adjacent to the first housing portion. (Fig. 1 & Fig. 2)

Regarding claim 17, Janninck teaches a user interface on the inner surface of the second housing that is inaccessible when adjacent to the first surface and accessible to a user's index finger when the second housing portion is in the open position. (Fig. 1, Fig. 2 and Col. 3 lines 22-35)

Regarding claim 18, Janninck teaches an open position and a closed position. (Fig. 1 & Fig. 2)

Regarding claim 19, Janninck teaches two housing portions with a circular portion and an extending portion. (Fig. 2 & Fig. 4) Janninck teaches the housing portions are planarly aligned and connected together at the circular portions so that housing portions can rotate in the plane. (Fig. 2) Janninck teaches a user interface (Fig. 2 [234]) on the first housing extending portion adjacent to the resting position of a user's index finger. (Fig. 2)

Regarding claim 20, Janninck teaches a second housing portion with a second surface opposite of the first surface. (Fig. 1 & Fig. 2)

### ***Response to Arguments***

7. Applicant's arguments filed 3/10/2005 have been fully considered but they are not persuasive.

8. In response to the applicant's argument regarding the accessibility of a user interface and keypad (Page 10 Para. 2-3), Janninck teaches a keypad (Fig. 2 [232]) on the second housing (Fig. 2 [220]) that is accessible when the first housing (Fig. 2 [120]) is in the open position (Fig. 2) and inaccessible when the first housing (Fig. 1 [120]) is in the closed position. (Fig. 1) Janninck teaches a user interface (Fig. 2 [234]) that is accessible when the first housing (Fig. 2 [120]) is in the open position (Fig. 2) and inaccessible when the first housing (Fig. 1 [120]) is in the closed position. (Fig. 1 and Col. 3 line 58 through Col. 4 line 7)

In response to the applicant's argument regarding a user interface disposed upon the first surface of the second extending portion (Page 10 Para. 4 through Page 11 Para. 1), Janninck teaches a first surface of the second extending portion (Fig. 2 [230] that has a user interface (Fig. 2 [234]) located adjacent to the resting position of a user's index finger.

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew C. Sams whose telephone number is (571)272-8099. The examiner can normally be reached on M-F 7:30-5.

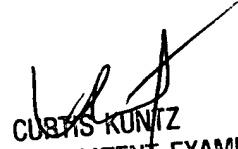


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on (571)272-7499. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MCS  
9/8/2005

  
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